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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/560,044 | 12/08/2005 | Takehiko Tojo | 281680US3PCT | 9436 |
| 22850 7590 12/18/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER STETZ, RACHEL RUNNING | | | | |
| ART UNIT 3732 | | PAPER NUMBER | | |
| NOTIFICATION DATE 12/18/2009 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/560,044

Applicant(s)

TOJO ET AL.

Examiner

RACHEL R. STEITZ

Art Unit

3732

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7-10, 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. It appears that Japan 2004-015222 is the Japanese patent application of US 10/560,044. Japan 2004-008099 does not appear to be related to application 10/560,044 therefore it will not receive the foreign priority date 1/15/2004, because without a foreign translation it appears based on the drawings of 2004-008099 is a different invention than that of the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, 7-9, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (PCT WO 03/00752).

Regarding claim 1, Kobayashi et al. disclose a hair holder comprising a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end toward an opening at the other end such that when the hair holder is rolled up the sheet which forms the first side is on an outside of the tube. The sheet which forms the first side of the tube is more

extensible in the length direction than the sheet which forms the second side of the tube and the sheet which forms the second side of the tube as a Taber stiffness of 0.4 mNm (see Figure 22). The sheet which forms the first side has a large number of openings to make the sheet extendable (see Figure 8). Regarding claim 5, the sheet is permeable to a hair treating agent. Regarding claim 7, the tube is designed to roll itself up into a prescribed shape.

Regarding claim 8, Kobayashi et al. disclose the method of treating hair including a flat tube having a sheet which forms a first side and a sheet which forms a second side the sheet which forms the first side of the tube is more extensible in the length direction of the tube than the sheet which forms the second side of the tube, the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the method includes inserting a hair bundle through the tube of the hair holder and rolling up the tube having the hair therein (see Figures 24a-24d). Regarding claim 16, the device has reinforcing strip in the hair holder (see Figures 17a and 17b).

Kobayashi et al. disclose the claimed invention except for the first side of the sheet having at least 15 times higher of an extension under a load of 5 N as of the second sheet, the sheet which forms the first side having an extension of at least 5% under a load of 5 N, the sheet which forms the second side has an extension of 5% or less under a load of 5 N, the sheet which forms the first side has the extensibility of at least 30 times the extensibility of the sheet which forms the second side under the load of 5 N.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first side of the sheet be at least 15 times higher of an extension under a load of 5 N than the second sheet, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheet which forms the first side be an extension of at least 5% under a load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheet which forms the second side have an extension of 5% or less under a load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to the sheet which forms the first side has the extensibility of at least 30 times the extensibility of the sheet which forms the second side under the load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Amendment

5. The declaration under 37 CFR 1.132 filed September 4, 2009 is insufficient to overcome the rejection of claims 1, 3, 5, 7-9, and 14-16 based upon the 103 rejection as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. Further the test should show the results of the test performed on the invention as claimed and the closest prior art, precisely what was done should be recited in the declaration, the actual steps carried out, and the materials employed. Examples 1 and 2 are not discussed in the declaration neither are comparative examples 1 and 2. Further the showing of unexpected result must commensurate in scope with the invention as claimed, in this instance it is unclear whether it is the actual extensibility that performs the unexpected results or the materials, load, ect.

Response to Arguments

6. Applicant's arguments filed September 4, 2009 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the JP 2004-0089099 priority claim is proper, since there is no translation for JP 2004-0089099 the Examiner can only determine from the drawings if the applications are related. It appears that JP 2004-

0089099 is a hair curler with an adhesive used to secure the hair curler in the rolled up configuration this is a different invention from what is previously being claimed in the present application; therefore, the devices are unrelated.

8. In response to applicant's argument that Kobayashi would not have found the claimed range to be routine since the claimed range is an unexpected result obtained by the inventors. The declaration is insufficient to establish unexpected results, therefore, it would have been obvious to one having ordinary skill in the art to find the optimum range based on routine experimentation.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL R. STEITZ whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/
Examiner
Art Unit 3732